

Remarks

The following numbered paragraphs are provided to respond to the similarly numbered paragraphs in the Office Action (e.g., paragraph "1" below corresponds to paragraph 1 in the Office Action).

As an initial matter, Applicant believes that at least some of the originally filed claims in this application are generic to several of the embodiments and that at least some of those generic claims are allowable over the art of record as at least some of the species covered by the generic claims are supported by the parent specification that predates Yarin. Here, Applicant requests that if the Examiner determines that at least some of the claims are generic and allowable over the art considered by the Examiner, that the Examiner reinstate any withdrawn claims that are covered by the generic claims.

1-5. The Office Action rejected each of claims 4, 5, 9, 10, 28, 29 and 33 as obvious over Yarin in view of Mucciacciaro.

The Examiner has applied Yarin and Mucciacciaro as if there is a 102 (anticipation) rejection as opposed to a 103 (obviousness) rejection to claim 4. To this end, claim 4 does not require indicia and Mucciacciaro is only cited for teaching visual indicia. Thus it appears as though the Examiner intended to issue a 103 rejection of claim 4.

In addition, with respect to claim 5, there is no discussion of claim 5 in the most recent Office Action and therefore Applicant cannot respond in a meaningful way. In this regard, if the Examiner maintains the rejection of claim 5, Applicant does not believe the next Office Action should be final and hereby requests a non-final next action.

With respect to claim 4, claim 4 which was solely rejected based on Yarin has been amended so that claim 4 is now fully supported by the parent patent (US 6,259,654) to this application. To this end, amended claim 4 now requires that a container be supportable adjacent a sensor surface such that a memory device is adjacent the sensor surface. Here, see the embodiments in Figs. 27, 30 and 32 of parent patent '654 where containers are supported adjacent sensor surfaces. Claim 5 has also been amended so that it is fully supported by the '654 parent patent.

With respect to claims 9 and 10, each of claims 9 and 10 has been amended to be fully supported by the '654 parent patent. To this end, claim 9 now requires that a facing surface of a container that is adjacent a sensor surface have essentially the same shape as an aligner used to align the facing surface with the sensor surface. In this regard, see Fig. 33 of the '654 patent that shows a sensor 940 that forms a surface that has essentially the same shape as the facing surface 952 of a container 950. In addition, see the Fig. 29-30 embodiment in the '654 patent that shows an aligner 875 that has a shape that is similar to the shape of the facing surface of a vial adjacent thereto. Claim 10 simply requires that the container include a vial which is shown in many of the embodiments of the '654 patent.

With respect to claim 28, amended claim 28 simply requires that a facing surface of a container be adjacent a sensor surface when the container is adjacent the sensor surface which is clearly supported by the '654 parent patent as seen in Figs. 27, 30 and 32. Claim 29 includes limitations similar to the limitations in claim 9 and is fully supported by the '654 patent for the reasons discussed above.

With respect to claim 33, claim 33 simply requires that a processor cause the sensor to periodically scan the sensing area to identifying specifying devices. This feature is fully supported by the '654 patent where it is taught that when a specifying

device is located adjacent a sensor, the sensor obtains information from the specifying device. In this example, the sensor only reads the information periodically (i.e., when a device is adjacent thereto) and the reading process has to be started by a processor so the claim limitations are fully supported.

Thus, Yarin is no longer prior art to any of claims 4, 5, 9, 10, 28 or 29 and the current rejections should be withdrawn.

6-7. The Office Action rejected claim 107 as obvious over Glynn. Applicant strongly traverses this rejection. To this end, the claimed invention is intended to cover a system wherein a processor automatically determines a medicant dosing regimen the first or initial time that a medicant container is sensed by a sensing device and without requiring a user (e.g., the person that a medicant has been prescribed for) to manually enter the dosing regimen information. Consistent with this function, claim 107 is drawn to a method that requires that, prior to an initial time that a sensing device (e.g., a device on a container) is disposed within the sensing area, the specifying information specified by a specifying device has not been received by a processor. In addition, claim 107 requires that, at the initial time a specifying device is within the sensing area, the processor receives the specifying information a first time from the specifying device (i.e., the specifying information was not received by the processor a prior time) and uses the specifying information to identify prescribed dosing regimen information.

Turning to Glynn, the Office Action indicates that whether specifying information is stored in a RAM by a user scanning a container or is programmed therein manually by a user prior to use of the device is a matter of designer choice. As an initial matter Applicant point out that if a possibility has not been recognized in the prior art, that possibility cannot possibly be a matter of designer choice. In short, an unknown possibility is not a choice at all, much less an obvious choice.

In this regard, the Examiner has been unable to identify even a single reference that predates the parent patent to this application where prescription information was obtained automatically from a specifying device on a medicant container. For this reason, this possibility was not a choice at all prior to the filing of the parent patent and hence clearly could not have been a matter of designer choice.

Consistent with this understanding of the state of the prior art prior to filing of the parent patent, Glynn completely fails to teach or even remotely suggest that specifying information could be read from a vial. Instead, Glynn teaches that a system user has to manually enter prescription information into a system which is then correlated with a specific container. To this end, see Glynn's col. 4, lines 39-48, where Glynn teaches that medication container identity can be initialized by placing a container including a bar code on the bottom thereof on a tray. When a sensor senses that a container has been placed on the tray (i.e., via a weight change of the face of the tray), the tray is scanned and the bar code read. When a new bar code is recognized, the system prompts the user to manually enter prescription information which is then stored for the container.

Thus, Glynn cannot obviate claim 107 because neither Glynn nor any other cited reference prior to the filing date of the parent patent taught or suggested automatically obtaining specifying information from a specifying device on a container when the device is placed adjacent a sensor. Because the claim limitations were not recognized as an option prior to the parent filing date, the limitations cannot possibly be a matter of designer choice and the current rejection of claim 107 and claim 108 that depends there from should be withdrawn.

In the event that the Examiner rejects claims 107 and 108 again Applicant requests that the Examiner cite a reference that at least shows that prior to the filing date of the parent application the concept of a sensor automatically obtaining prescription information from a vial or the like was known and hence was at least a possible choice.

Claim Objections. Applicant has amended claim 107 to overcome the stated objection regarding "sensing device".

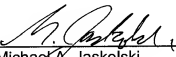
Applicant has introduced no new matter in making the above amendments and antecedent basis exists in the specification and claims as originally filed for each amendment. In view of the above amendments and remarks, Applicant believes claims 1, 4, 5, 7-10, 15, 17, 22-29, 33, 36 and 107-108 of the present application recite patentable subject matter and allowance of the same is requested.

No fee in addition to the fees already authorized in this and accompanying documentation is believed to be required to enter this amendment, however, if an additional fee is required, please charge Deposit Account No. 17-0055 in the amount of the fee.

Respectfully submitted,

CARLOS DE LA HUERGA

Date: 10-22-08

By: 
Michael A. Jaskolski
Reg. No. 37,551
Attorney for Applicant
QUARLES & BRADY, LLP
411 East Wisconsin Avenue
Milwaukee, WI. 53202-4497
(414) 277-5711